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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/454,529	05/30/1995	JAMES J. HOGAN	212/083	7594
7590	12/17/2003			EXAMINER
CHARLES B CAPPELLARI GEN-PROBE INCORPORATED PATENT DEPARTMENT 10210 GENETIC CENTER DRIVE SAN DIEGO, CA 92121			MARSCHEL, ARDIN H	
			ART UNIT	PAPER NUMBER
			1631	
			DATE MAILED: 12/17/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	08/454,529	HOGAN ET AL.
	<b>Examiner</b> Ardin Marschel	<b>Art Unit</b> 1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 486-630 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 486-491,509,512,513,555-558,561,562,603,604,609, and 610 is/are rejected.  
 7) Claim(s) 492-508,510,511,514-554,559,560,563-602,605-608, and 611-630 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) The translation of the foreign language provisional application has been received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

1)  Notice of References Cited (PTO-892)  
 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3)  Information Disclosure Statement(s) (PTO-1449) ~~Excluded (14 sheets)~~  
 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
 5)  Notice of Informal Patent Application (PTO-152)  
 6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

### **WITHDRAWAL OF SUSPENSION FOR INTERFERENCE**

Due to the newly found issues summarized below, the suspension for interference is hereby withdrawn in order to address said new issues.

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are newly applied. They constitute the complete set presently being applied to the instant application.

## **PRIOR ART**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 486-491, 509, 512, 513, 555-558, 561, 562, 603, 604, 609, and 610 are rejected under 35 U.S.C. 102(e)(2) as being clearly anticipated by Stanbridge et al. (P/N 5,851,767).

It is firstly noted that the disclosure of the reference was originally filed in a parent application on May 4, 1985, which predates the earliest priority document filing date regarding the instant application.

The title and abstract of the reference directs the invention therein described to the detection of various microorganisms via ribosomal RNA sequence. In column 2,

lines 15-31, differential detection via mycoplasma-specific (target as instantly claimed)

probes is described to distinguish over E. coli (non-target as instantly claimed).

Hybridization assay methodology using such probes is summarized in columns 3-6

which is also the assay methodology as instantly claimed. Several mycoplasma-

specific probes are set forth in the reference. Several such probes are disclosed in

column 2, lines 15-31. The reference Frydenberg et al. [DNA 4(2) 127-137(1985)] is

useful to position these probes in 16S mycoplasma sequence but is only set forth here

for this information, whereas the rejection is based on the disclosure of hybridization

assays utilizing said probes. Considering the probes in column 2 of Stanbridge et al. as

to locating them within the page 129 Mycoplasma PG50 16S ribosomal sequence

reveals that certain probes are located in 16S regions as instantly claimed. For

example, the 5<sup>th</sup> probe in column 2 of Stanbridge et al. is TCTCAGTTGGATTGA

which is located in Mycoplasma 16S sequence at positions 1273-1288. This is within

the 1250-1290 region as instantly claimed in claim 486. Another example, is

mycoplasma-specific probe AGGTGGTGCATGGTTG which is located in 16S sequence

at positions 1026-1041 which is in the 980-1060 region as instantly claimed. Therefore,

the instantly claimed hybridization methods which distinguish target mycoplasma

organisms, deemed inclusive of Mycoplasma pneumoniae as cited in Stanbridge et al.

in column 6, lines 31-35, from E.coli as a specie of non-target via probes in the 16S

sequence regions cited above are anticipated.

## CLAIM OBJECTIONS

Claims 492-508, 510, 511, 514-554, 559, 560, 563-602, 605-608, and 611-630 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

December 12, 2003

*Ardin H. Marschel*  
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